



PATENT
7586D3033

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
SMITH, et al)
Serial No: 08/392,934)
Filed: September 15, 1993)
For: IMMUNOREACTIVE PEPTIDES FROM)
EPSTEIN-BARR VIRUS)

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington D.C. 20231, on

October 23, 1996
Date of Deposit

Wei-ning Yang
Name

[Signature] 10/23/96
Signature Date

RENEWED PETITION UNDER 37 CFR 1.48 (a)

Attention: PCT Legal Office
Assistant Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

In response to the Decision on Petition dated May 23, 1996, a three-month extension of time having been requested extending the response period to October 23, 1996, enclosed are the following:

- (1) a new Statement of Facts verified by the original named inventors. The new Statement of Facts clearly establishes when the error without deceptive intent was discovered and how it occurred and corrects misstatements in the prior declaration;
- (2) a facsimile copy of the Declaration of John R. Wetherell, Ph.D. the original prosecuting attorney, regarding how the mistake occurred
- (2) a new Declaration executed by Richard Smith, Gary Pearson, D. Elliot

Parks and Susan Varghese, identifying the prior parent U.S. application, of which the present application is a CIP;

- (3) a copy of the executed assignment;
- (4) a new Assent of Assignee to Addition to Originally Named Inventors;
- (5) a Power of Attorney by Assignee; and
- (6) a petition for three-month extension of time and a check in the amount of \$930.00 to cover the extension fee.

Applicants believe that the newly submitted documents should overcome the rejections, made by the PTO in its Decision on the petition dated May 23, 1996, to the prior petition for adding Dr. Susan Pothan Varghese as a co-inventor to the application. In light of the newly submitted documents and the following remarks, reconsidering the merits of the petition is respectfully requested.

In the Decision, the PTO pointed out that there was no indication when in 1994 Dr. Varghese completed her Ph.D dissertation, and Gary Peterson became concerned that Mr. Varghese might have made certain contributions to the invention. Also, the PTO pointed out that there was no indication that when it was concluded that Dr. Varghese was an inventor.

In response, a thorough investigation of the events happened around the inventorship issue was carried out. Such investigation reveals that several statements made in the previous filed verified statement of facts are incorrect.

In particular, the statement that Dr. Pearson became concerned that Susan Varghese might have made certain contributions to the invention after she completed

her Ph.D dissertation in 1994 was incorrect; rather, it was the submission of Dr. Varghese's Ph.D thesis in about September 1994 to the attorneys responsible for prosecuting the application that ultimately led the attorneys to conclude that Dr. Varghese should have been named as an inventor.

According to the newly submitted verified statement of facts by inventors and the declaration of Dr. John Wetherell, Jr., the prosecuting attorney, Dr. Pearson who worked with Dr. Varghese, the omitted inventor, did not review the application before it was filed. Dr. Parks was unaware of Dr. Varghese's role as they were located on opposite coasts. As a result, when it came to naming the inventors of the grand parent application as filed in September 1992, the attorneys and Dr. Parks were unaware that Dr. Varghese should be an inventor.

Dr. Pearson became concerned about Dr. Varghese's role as an inventor shortly after his execution of the Oath and Declaration to the grandparent application filed on September 15, 1992. Thereafter, in about November, 1992, as shown by the newly submitted verified statement of facts, he and other inventors tried diligently to ascertain the role of Dr. Varghese as an inventor. Dr. Pearson then passed this request on to the attorneys who were responsible for prosecuting the application.

This request was provided to Dr. John Wetherell, the attorney who was responsible for prosecuting the grandparent application in the spring of 1993. Dr. Wetherell then had contact with Dr. Varghese's employer regarding inventorship. As detailed in Dr. Wetherell's declaration, Dr. Wetherell received erroneous information from Dr. Varghese's employer about the inventorship and so concluded that Dr.

Varghese was not the inventor.

In about August 1994, Dr. Pearson learned that Dr. Varghese had not been named an inventor, resulting in further efforts to ascertain what Dr. Varghese's role was. After receiving Dr. Varghese's PhD. thesis in about September, 1994, Stacy Taylor nee Howells concluded that Dr. Varghese should have been named as an inventor and steps were undertaken to correct inventorship through WIPO.

In light of the forgoing, applicants believe that the newly submitted verified statement of the facts has addressed the issues raised by the Decision regarding item (1).

In the Decision, the PTO also stated that the declaration submitted was defective in that it failed to identify the prior U.S. application. In response, a newly executed Declaration is submitted which correctly identifies the prior U.S. application having an earlier filing date than the present application.

In the Decision, the PTO pointed out the written consent of any assignee was defective for the lack of documentary evidence of a chain of title, and for the lack of apparent authority to sign on behalf of the assignee. In response, a new assent of assignees is submitted which indicates that the undersigned are empowered to sign on behalf of the respective assignee, and which also indicates that the assignments are concurrently submitted for recordation under the separate cover sheet.

In light of the forgoing, it is believed that the newly submitted documents have addressed all the issues raised by the PTO in its Decision. Therefore, Applicants respectfully requests the PTO to grant the petition for adding Dr. Susan Pothen

Varghese as a co-inventor to the application.

The commissioner is hereby authorized to charge any fee deficiencies or credit any overpayments associated with this Renewed Petition to the Deposit Account of the undersigned, Deposit Account No. 12-1820.

Respectfully submitted,

LOEB AND LOEB

Date: October 23, 1996

By: 

WEI-NING YANG

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